

Rejection of Claims 1, 5-8, 12 and 13 Under 35 U.S.C. § 102(b)

The Examiner has rejected Claims 1, 5-8, 12 and 13 under 35 U.S.C. § 102(b) as being anticipated by United States Patent No. 874,666, granted to Rodrigues-Ely ("Rodrigues-Ely").

To constitute an anticipation, all material claimed features and limitations must be contained within the four corners of the prior art reference. In re Coker, 175 USPQ 26 (CCPA 1972) and In re Outtrup, 189 USPQ 345 (CCPA 1976). In this instance, Rodrigues-Ely cannot, *ipso facto*, anticipate Claim 1 as it neither discloses, references, teaches or suggests any use, modification or application of the torch tip "in combination with an internal combustion engine." Moreover, the cases cited by the Examiner in support of his contention that the cited reference "meets the claim" are not on point. Each case deals with rejections based on obviousness wherein a combination of references was cited. On these grounds alone, the rejection must be withdrawn.

Furthermore, Rodrigues-Ely does not disclose what Applicant claims. In the context of Applicant's claims, Rodrigues-Ely fails to disclose the concentric tube terminating substantially flush with the outlet end of the body member. In the drawing for Rodrigues-Ely the body member is flush with neither the central tube nor the outlet ports, being apparently shortened to accommodate the mouthpiece.

With respect to Claims 5-8, analogous arguments apply. Moreover, with respect to these claims Rodrigues-Ely does not disclose coupling members engaging an inlet end of either the angular bore or the straight bore. To rely on inherency, the Examiner is not permitted to engage in conjecture or supposition, the allegedly inherent feature must be essential such that the disclosed device could not exist without it. Here, the Examiner has not made the showing required for reliance on inherency. See In re Robertson, Fed. Cir. 98 - 1270 February 25, 1999.

This is further emphasized by the fact that Rodrigues-Ely, from the drawing relied upon by the Examiner, does not disclose a coupling member engaging the inlet end of the straight bore.

Lastly, analogous arguments apply to both Claims 12 and 13, each depending from Claim 1, which is patentable. In addition, Rodrigues-Ely does not anticipate Claim 13 as it utterly fails to disclose "a threaded region" in what would be identified, taking Applicant's claims, as the body member (let alone such region used "for engaging a manifold port of the internal combustion engine.")

In view of the foregoing, Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. § 102(b).

Rejection of Claims 1, 4-8 and 10 Under 35 U.S.C. § 102(b)

The Examiner has also rejected Claims 1, 4-8 and 10 under 35 U.S.C. § 102(b), as being anticipated by United States Letters Patent No. 3,477,112, issued to Yerkins ("Yerkins").

Applicant respectfully traverses this rejection.

Applicant claims a nozzle used in combination with a combustion engine. Moreover, the nozzle provides a nitrous oxide/fuel mixture. Yerkins discloses a torch tip for heating and cutting metals dispensing a heating jet and a pure oxygen jet. Nothing in Yerkins teaches or suggests that the disclosed torch tip is used in combination with a combustion engine or that it provides a nitrous oxide fuel mixture to a combustion cylinder. As such, Yerkins does not anticipate Applicant's Claim 1.

Since Yerkins does not anticipate Claim 1, it is incapable of anticipating Claims 4- 6, 12 and 13, being claims dependent from Claim 1. With respect to Claim 5 and independent Claim 7, Yerkins does not disclose separate coupling members engaging the inlet end of the angular and

straight bores, respectively. This is clear by the description at column 4, lines 4-11, wherein a single threaded cap, 52, is the coupling means for both gas sources. No doubt, such coupling is enabled by the proximity of, using Applicant's claim language, the concentric tube and the angular bore in Yerkins at end 12. Notwithstanding Applicant's arguments against the Examiner's application of inherency in Rodrigues-Ely as to the necessity of coupling means, clearly the Examiner cannot so rely on inherency to demonstrate the necessity of two coupling members in Yerkins.

With respect to Claim 12, the need for the annular gas passageways in Yerkins to be nearly parallel to the central passageway, so as to utilize the single threaded cap, 52, likely precludes the annular passageways having an angle to the central passageway greater than five degrees. In any event, the Examiner has not shown where Yerkins discloses an angular bore defining an angle greater than five degrees with respect to a straight bore, as Applicant claims. The Examiner, therefore, has not carried his burden to demonstrate that Yerkins discloses Applicant's claim 12.

In view of the foregoing, Applicant requests the Examiner withdraw the rejection in view of the Yerkins reference.

Rejection Of Claim 2 Under 35 U.S.C. § 103(a)

The Examiner has rejected Claim 2 under 35 U.S.C. § 103(a) as being unpatentable over Rodrigues-Ely in view of U.S. Letters Patent No. 4,248,384 issued to Zwicker ("Zwicker"). With respect to this rejection, as the Applicant has previously described the Rodrigues-Ely torch identified in that invention does not anticipate Claim 1 in the application for the reasons given. As such, since Claim 2 is dependent upon Claim 1 and thereby incorporates all of its limitations

and structure, The combination of the Rodrigues-Ely invention with the Zwicker patent does not anticipate or render obvious Applicant's invention. The only addition by the Zwicker patent, *i.e.* use of stainless steel construction (an attribute neither taught nor suggested by Rodrigues-Ely) does not cure the deficiencies of Rodrigues-Ely noted above as a reference.

Furthermore, Applicant contends that given the application of its invention to internal combustion engines, as indicated in its amended Claim 1, that the cutting torch tips disclosed by Rodrigues-Ely and Zwicker are non-analogous art, neither teaching nor suggesting what Applicant claims.

Rejection Of Claims 3 and 9 Under 35 U.S.C. § 103(a)

The Examiner has rejected Applicant's Claims 3 and 9 under 35 U.S.C. § 103(a) as being unpatentable over Rodrigues-Ely in view of United States Letters Patent No. 3,866,839, issued to Magner ("Magner"). As Applicant has previously argued, Rodrigues-Ely does not anticipate Applicant's Claim 1, the claim from which Claim 3 depends. Moreover, the Examining Attorney points to no structure or elements present in the Magner reference disclosing "radially spaced outlet ports and a center bore of a size to receive and engage the tube such that fluid communication through the center bore around the tube is prevented." As demonstrated by the drawings of Magner, the outlet portion of this invention 122 is contained within a sleeve 16 mounted over a tip 40. As to the space or "bore" of this sleeve, using Applicant's claim language, any fluid flowing through the tip flows through the interior bore of the sleeve. Thus, as disclosed in Magner, the sleeve element does not prevent communication through a central bore.

Rejection Of Claims 4 and 10 Under 35 U.S.C. § 103(a)

The Examiner has also rejected Claims 4 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Rodrigues-Ely in view of Yerkins. Again, Applicant reiterates that Rodrigues-Ely does not anticipate any claims recited in the instant application for the reasons discussed previously. Nor does Rodrigues-Ely teach or suggest use of the hub 44 disclosed in Figure 3 of Yerkins. As such, this assembly would not be compatible with the multi-portal outlet structure disclosed in Rodrigues-Ely. Moreover, as stated previously, the inventions in both Rodrigues-Ely and Yerkins are drawn to torch tips and hence are non-analogous to Applicant's claimed invention and do not teach or suggest that invention. The Examiner is therefore urged to withdraw this rejection.

Rejection Of Claim 11 Under 35 U.S.C. § 103(a)

Lastly, the Examiner has rejected Claim 11 as being unpatentable over Rodrigues-Ely in view of United States Letters Patent No. 3,838,820 issued to Pearce ("Pearce"). Once again, Applicant reiterates its arguments with respect to Rodrigues-Ely, which does not anticipate any of the claims recited by Applicant in the instant application. Applicant also points out the incompatibility of Rodrigues-Ely, featuring multi-portal outlets, with the torch tip disclosed by Pearce effectively teaching away from the combination asserted. As such, the Examiner has not provided sufficient explanation as to how Rodrigues-Ely teaches its combination with the Pearce apparatus with its inner and outer copper tubes construction. Absent such some motivation, teaching or suggestion, the combination of reference cited by the Examiner necessarily fails to set forth a *prima facie* case of obviousness let alone to obviating Applicant's invention in a non-analogous field. Withdrawal of this rejection is respectfully requested.

CONCLUSION

In view of the foregoing, Applicant believes by virtue of its arguments and amendments that all claims presented are in condition for allowance. Such action is requested at the earliest possible date. Applicant therefore requests favorable consideration by the Examiner and allowance of its claims at the Examiner's earliest opportunity.

REQUEST FOR EXTENSION OF TIME

In accordance with 37 C.F.R. § 1.136(a), the Applicant for the above-identified Application respectfully petitions the Commissioner for a one-month extension of time, extending the period for response to the outstanding communication to October 18, 1999. A check in the amount of \$55.00 for the one-month extension of time filing fee is enclosed herewith.

Respectfully submitted,

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Date: October 18, 1999

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: BOX AF, Assistant Commissioner for Patents, Washington D.C. 20231 on October 18, 1999.


Laura Harmon

October 18, 1999